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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/001,521

10/26/2001

James C. Phillips

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7590

10/18/2006

DUANE MORRIS, LLP

IP DEPARTMENT

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PHILADELPHIA, PA 19103-4196

EXAMINER

HARRELL, ROBERT B

ART UNIT

PAPER NUMBER

2142

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/001,521

Applicant(s)

PHILLIPS, JAMES C.

Examiner

Robert B. Harrell

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2006 et al..
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 23-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 1-19, 23-41, 45 and 46 is/are allowed.
- 6) ☒ Claim(s) 42-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☒ Other: see attached Office Action.

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1. Claims 1-19 and 23-44 are presented for examination.

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claims 42-44 are rejected under 35 U.S.C. 101** because the claimed invention is directed to non-statutory subject matter since such reads on (**encompass**) printed matter and/or carrier waves (e.g., see page 20 (lines 2-9) of this applications specification) as such lack being **embodied on a tangible computer readable storage medium** (In re Beauregard (CAFC) 35 USPQ2d 1383) and MPEP 2106).

4. The rejection, and grounds for rejection, under 35 U.S.C. 101 as presented in examiner's prior Office Action mailed 10 February 2006, are hereby maintained and incorporated in this Office Action by reference.

5. The applicant argued in his 10 August 2006 response by stating in substance that the Examiner has rejected claims 42-44 as being non-statutory subject matter directed to "printed matter and/or carrier waves." Applicant respectfully disagrees with the examiner and is somewhat mystified by the Examiner's assertion. As stated clearly in the preamble of claim 42, the claim is directed to a computer readable medium encoded with computer program code. Similarly, claims 43 and 44 start with the preamble the computer readable medium of claim 41. Claims directed toward computer readable media are patentable [statutory] subject matter. However, the claims **encompass** non-statutory subject matter as disclosed on page 20 (lines 2-9) of this application such as transient carrier waves over a link (i.e., downloads and/or uploads), or more so, as electromagnetic radiation (line 6); each readable by a computer. In addition, obsolete stacked punch cards are printed matter as is text on paper that can be OCR'd (Optical Character Recognized) scanned by the computer, web page(s), and even the pits on a CD which equate to etching in stone each human and computer readable by the eye. As per page 20 (line 6), magnetic radiation is a computer readable medium be it through open space or guided by wire, channel, link, and/or the like, but is nonetheless carrier wave. Also, downloads and/or uploads, or other means of transferring is non-statutory subject matter. Use of "**embodied on a tangible computer readable storage medium**", or the like, will moot this issue and permit the application to become allowed.

6. The applicant should always use this period for response to thoroughly and very closely proof read and review the whole of the application for correct correlation between reference numerals in the textual portion of the Specification and Drawings along with any minor spelling errors, general typographical errors, accuracy, assurance of proper use for Trademarks TM, and other legal symbols ®, where required, and clarity of meaning in the Specification, Drawings, and specifically the claims (i.e., provide proper antecedent basis for "the" and "said" within each

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claim). Minor typographical errors could render a Patent unenforceable and so the applicant is strongly encouraged to aid in this endeavor.

7. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this Office Action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Harrell whose telephone number is (571) 272-3895. The examiner can normally be reached Monday thru Friday from 5:30 am to 2:00 pm and on weekends from 6:00 am to 12 noon Eastern Standard Time.

9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew T. Caldwell, can be reached on (571) 272-3868. The fax phone number for all papers is (703) 872-9306.

10. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.


ROBERT B. HARRELL
PRIMARY EXAMINER
GROUP 2142